

REMARKS/ARGUMENTS

By this amendment, claims 1-17 and 28-49 are canceled, and claims 50-90 are added. Accordingly, claims 50-90 are pending further examination. Reconsideration in view of the above amendment and following remarks is respectfully requested.

Claim Rejections – 35 U.S.C. § 112

First, it is believed that the above added claims render the previously issued 35 U.S.C. § 112, second paragraph rejections moot. Accordingly, withdrawal of these rejections is respectfully requested. However, in order to facilitate prosecution on merits of this Application, Applicants have the following comments regarding some of the previously issued § 112 rejections.

1) For claims 1-17 and 29-49, the term “allows” is no longer recited in the claims and is believed to render moot the Final Office Action’s objection to the use of this term.

2) The erroneous rejection of claim 2 is moot because “a network” is no longer recited in the claims.

3) The rejection of claims 9-16 is moot because the “server system” that the Final Office Action alleged lacked antecedent basis is no longer recited in the claims.

4) Again, the term “allows” is no longer recited. Second, the language “for how the order executes with contra side quotes/orders in the trading venue” defines the structure of what the priority type was. Thus, contrary to the Final Office Action’s assertion, this limitation was not merely an intended use limitation.

5) Claim 34 previously recited, in combination, “the method comprises: receiving... executing...” The Final Office Action alleged that this claim was directed to *two* statutory

classes. However, this claim only included gerunds as recited elements and was thus properly directed to one statutory class – e.g., “process.”

To expand the erroneous nature of the Final Office Action’s rejection of claim 34, and to ensure that such is not made against method claims 77 and 88, to Applicant, it appears that under the Final Office Action’s legal theory, a method of moving a ear that includes a step of “applying a force to a car” would not be permitted simply because “a car” is recited. However, this plainly is not a correct application of the law. This is still a method step. Nor would it be correct to reject a method with a step that recited, “applying, via a hand jack, a force to a car.” The fact that a hand jack is used in the method step does not make the method step a “hybrid” claim. Accordingly, it is believed that this rejection was erroneous and should be withdrawn and should not be applied to method claims 77 and/or 88.

6 & 7) The alleged antecedent basis objections are moot in view of the added claims.

Claims Rejections – 35 U.S.C. § 101

Claims 34-39 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed for at least the following reasons.

As the Final Office Action continues to rely upon the *Lyell* case, Applicant has reproduced the claim at issue from *Lyell* below.

2. An automatic transmission tool in the form of a workstand and method for using same comprising:
 - a support means,
 - and [sic] internally splined sleeve affixed upright to said support means,
 - a threaded adjustment bolt threadably engaged through a hole in the bottom of said support means and projecting upward through said support frame into said sleeve,
 - and further comprising the steps of

1. positioning the output end of an automatic transmission onto said upright sleeve,
2. removing the internal components of said automatic transmission from the casing of said transmission,
3. repairing and replacing said internal components back into said casing, and
4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt.

Ex Parte Lyell, 17 USPQ2d 1548, 1549 (BPAI 1990). Thus, *Lyell*'s claim 2 comprised "a support means" (a machine) and the steps of "positioning...removing...repairing... adjusting" (a process).

In contrast, Applicant's claim 34 includes method steps of "receiving" and "executing" and no positively recited machine elements like there are in *Lyell*. In other words, there is no analog to *Lyell*'s "support means" or the "threaded adjustment bolt" positively recited under the transitional phrase of "comprises" in claim 34 (or new claim 77). Accordingly, there is no basis for relying upon the reasoning in *Lyell* as the facts of *Lyell* are completely different from those in the instant application. It is noted that the Federal Circuit and the PTO have continually cautioned on the broad application of rules from previously decided cases. Specifically, determination of the patentability of a claim (e.g., under § 101, 102, 103, or 112) is a fact intensive analysis where even a similar set of facts, to say nothing of a different set of facts, may lead very different results. *See, e.g.*, MPEP 2173.05.

Here, where the facts (e.g., the claim language) at issue are very different from those in *Lyell*, and there are no structural limitations in the claims, it is clear that the method claims (either canceled claim 34 or current claim 77) are directed to a "process" and not an additional statutory class, such as a "machine." Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejections 35 U.S.C. § 103

As an initial matter, it is respectfully noted that the Publication number of May is incorrectly recited (2002/013890) in the body of the Final Office Action. *See* Page 7. The correct publication number is 2002/0138390.

Applicant's claim 50 recites, in combination, "determine an execution priority from among a plurality of predetermined execution priorities based on the execution priority parameter selected by the user...wherein the determined execution priority determines, at least in part, which among the plurality of contra side quotes/orders the order is executed against."

Applicant's claim 84 recites, in combination, "wherein the execution of the order against the plurality of contra side quotes/orders is based on an execution priority that factors the respective size of each one of the plurality of contra side quotes/orders to determine which among the plurality of contra side quotes/orders the received order is executed against."

These features are not taught or suggested by May, NASD Rulemaking, or combination thereof.

The Final Office Action previously alleged that the "good until option" or the "credit preference" is an example of "order priority." *See* Pages 7 and 12. However, both of these examples have no aspect of priority to them. For example, the use of the good until option or the credit preference does not provide a teaching or suggestion that such an input will influence which contra side quotes/orders are used to fulfill the newly created order. Indeed, there is no discussion in May regarding how received orders are matched up against contra side orders. As there is no general discussion of how orders are executed against contra side quotes/orders, there is certainly no discussion of determination of "an execution priority from among a plurality of predetermined execution priorities based on the execution priority parameter selected by the

user” as is recited in claim 50 or an execution priority “that factors the respective size of each one of the plurality of contra side quotes/orders to determine which among the plurality of contra side quotes/orders the received order is executed against” as is recited in claim 84. Accordingly, May fails to teach or suggest each and every feature of independent claims 50 and 84 (and their respective dependent claims).

NASD Rulemaking fails to cure the above noted deficiencies of May. Specifically, there is no teaching or suggestion of determination of “an execution priority from among a plurality of predetermined execution priorities based on the execution priority parameter selected by the user” as is recited in claim 50 or an execution priority “that factors the respective size of each one of the plurality of contra side quotes/orders to determine which among the plurality of contra side quotes/orders the received order is executed against” as is recited in claim 84. Thus, the alleged combination of May with NASD rulemaking fails to render obvious independent claims 50 and 84. Further, independent claims 68, 77, 82, and 88 (and their respective dependents) are non-obvious over the alleged combinations for reasons similar to those set forth above. Withdrawal of rejections is therefore respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Respectfully submitted,

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